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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,393	03/22/2001	David N. Krag	34114-8001US1	5450

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EXAMINER

BAXTER, JESSICA R

ART UNIT	PAPER NUMBER
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3731

13

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,393

Applicant(s)

Krag, David N.

Examiner

Jessica R Baxter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-36, 65, 66, 68, 70-76, 78-88 and 90-99 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 88, 90, 91, 93-95 and 99 is/are allowed.
- 6) ☒ Claim(s) 32-36, 65, 66, 68, 70-76, 78-87, 92, 96 and 98 is/are rejected.
- 7) ☒ Claim(s) 97 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 32, 36, 68, 70-76, 78, 79, 80, 81, 82, 92, 93, 96 and 98 are rejected under 35

U.S.C. 102(b) as being anticipated by U.S. Patent no. 5,031,634 to Simon.

Simon discloses a tissue anchor comprising an elongate tube (12) having a central bore, a closed distal end (FIG. 3), wherein said tube has at least one aperture spaced proximally from said distal end (22,24); an elongate member (40, 50) having a portion sized for receipt and axial movement in said central bore from a first position and a second position (FIG. 6 and 7) and at least one anchor member (42,54) attached to said portion; and wherein said at least one anchor member has a free distal end carrying a tissue penetrating barb (42, 54) and is configured and positioned so that when said portion is in said first position said at least one anchor member is at least partially received in said elongate tube (FIG. 1) and when said portion is in said second position said at least one anchor member projects through said at least one aperture in a curved configuration and extends transversely relative to said longitudinal axis with the free distal end positioned outwardly of the elongate tube (FIG. 6), a stop (26, 28).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon '634 in view of U.S. Patent No. 4,643,196 to Tanaka et al.

Simon discloses the claimed invention except for the outside diameter of between 1 mm and 3 mm. Tanaka teaches that biopsy needles are provided above 1 mm in conventional biopsy needles to collect tissue specimens (Column 1 line 68-Column 2 line 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Simon with the outer diameter of Tanaka since the size is known to be used in conventional biopsy devices to collect tissue specimens.

5. Claims 35, 65, 66, 83-87 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simon '634 in view of U.S. Patent No. 4,799,495 to Hawkins et al.

Simon teaches the claimed invention except for the device having four anchor members.

Hawkins teaches that any number of anchor members may be provided to a biopsy needle device without changing the function of the device (Column 6 line 65-Column 7 line 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Simon with four anchors since it would not change the operation of the device.

Allowable Subject Matter

6. Claims 88, 90, 91, 93, 94, 95 and 99 are allowed.

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7. Claim 97 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 32-36 and 65-99 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

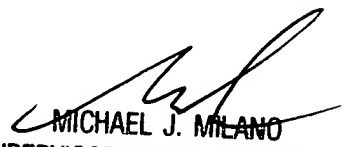
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


jrb

Jessica R Baxter
Examiner
Art Unit 3731


MICHAEL J. MILANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700